PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) **059643.00280**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: **10/733,635** Filed: **December 12, 2003**
	First Named Inventor: **Krisztian KISS, _et al._**
	Art Unit: **2446** Examiner: **Sulaiman NOORISTANY**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐   Applicant/Inventor.

☐   assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒   Attorney or agent of record.
    Registration No. 59,326

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    Registration Number if acting under 37 CFR 1.34

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May 19, 2009
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐   *Total of _____ forms are submitted.

In re application of: Krisztian KISS, *et al.*   Confirmation No.: 1642

Serial No.: 10/733,635   Group Art Unit: 2446

Filed: December 12, 2003   Atty. Docket No.: 059643.00280

For: REGISTRATIONS IN A COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents   May 19, 2009
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1, 4, 5, 7-11, and 20-30 in the above identified application. Claims 1, 4, 5, 7-11, and 20-30 were finally rejected in the Office Action dated March 12, 2009. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review, as the final rejections are clearly in error.

The final Office Action rejected claims 10 and 11 under 35 U.S.C. § 101 since the claimed invention was allegedly directed to non-statutory subject matter. Specifically, the Examiner took the position that claims 10 and 11 recite a system with a controller, which allegedly is a computer program, and therefore is considered to be non-statutory. Applicants respectfully submit that the rejection in the final Office Action is clearly erroneous for at least the reasons presented below.

Applicants respectfully submit that the term "controller" cannot be reasonably interpreted as a computer program by a person of ordinary skill in the art. But instead a person of ordinary skill in the art would interpret the term "controller" to be a physical thing, i.e., structural component. The "controller" in claim 10 is a structural component that is used to make up part of the system in claim 10. The "controller" in claim 10 is defined by the function it performs, i.e., "to query the user information storage and configured to process request for connections to the user based on the information queried from the database" (claim 10, lines 7-9). Because the term "controller" when taken in context with claim 10 would be interpreted by a person of ordinary skill in the art to be a physical thing, the subject matter of claim 10 is considered to be statutory under 35 U.S.C. § 101.

Furthermore, the contentions made in the pending Office Action are not supported by adequate reasons but instead provide a conclusory statement. Without the Examiner providing adequate support for such contentions, the rejection of claim 10 as being directed to non-statutory subject matter should not and could not stand. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn, since the term "controller" is clearly a physical structure and is considered to be statutory.

Regarding claim 11, because the term "controller" is not recited in claim 11, Applicants respectfully request that the rejection of claim 11 be withdrawn.

The final Office Action rejected claims 1, 4, 5, 8-11, and 20-30 under the second paragraph of 35 U.S.C. § 112. Specifically, the Examiner took the position that the limitation

> wherein the processing occurs in accordance with the information from the database if no user preference has been indicated for the known contact addresses, the user preference indicating if a request is to be forked in parallel or sequentially

in claim 1, for example, is indefinite, as it allegedly fails to conform with current U.S. Patent practice. However, Applicants respectfully submit that this rejection is clearly erroneous for at least the reasons presented below.

Claim 1 cannot be considered as being indefinite by a person of ordinary skill in the art, since claim 1 clearly recites that the processing occurs in accordance with (e.g. based on) the information from the database (claim 1, line 7). Furthermore, it would be rather clear to a person of ordinary skill in the art that the processing occurs "if no user preference has been indicated for the known contact addresses" (claim 1, lines 8-10).

Furthermore, the Examiner failed to indicate in the Office Action why a person of ordinary skill in the art would find the above-mentioned limitation of claim 1 to be unclear. Instead, the Examiner simply stated that the limitation of claim 1 is generally narrative and indefinite, and fails to conform with U.S. practice. This is clearly not the standard in the rejecting a claim under the second paragraph of 35 U.S.C. § 112, and, therefore is considered to be an erroneous rejection.

Therefore, for at least the reasons presented above, Applicants respectfully submit that claim 1 clearly satisfies the requirements under the second paragraph of 35 U.S.C. § 112. Claims 4-5, 8-11, and 20-30 also satisfy the requirements under the second paragraph of 35 U.S.C. § 112 for reasons similar to those discussed above with respect to claim 1.

Accordingly, withdrawal of the rejection is respectfully requested.

The final Office Action rejected claims 1, 4, 5, 7-11, and 20-30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanchez Herrero et al. (U.S. Patent No. 7,177,642) in view of Costa-Requena et al. (U.S. Patent No. 7, 028,101) and Maiocco et al. (U.S. Patent No. 7,478,151) and further

in view of Ohsawa et al. (U.S. Patent Publication No. 2003/0018684). The Examiner took the position that the combination of Sanchez Herrero et al., Costa-Requena et al., Maiocco et al., and Ohsawa et al. disclose each and every element of claims 1, 4, 5, 7-11, and 20-30. However, Applicants respectfully submit that this rejection is clearly erroneous for at least the reasons presented below.

As previously stated in the Response dated December 17, 2008, the Applicants indicated that Costa-Requena et al. and the above-identified application is assigned to Nokia Corporation. (Response dated December 17, 2008, page 13). As such, Costa-Requena et al. is disqualified as prior art under 35 U.S.C. § 103(c). 35 U.S.C. § 103(c)(1) states, in part, "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." (Emphasis added). For the purposes of United States law, a "person" may be a corporation. The only section of 35 U.S.C. § 102 that Costa-Requena et al. potentially qualifies under is 35 U.S.C. § 102(e), as the publication date of Costa-Requena et al. was after the filing date of the above-identified application.

However, because Costa-Requena et al. was under an obligation of assignment to Nokia at the time the claimed invention was made for the above-identified application, Costa-Requena et al. does not qualify as prior art per 35 U.S.C. § 103(c). Therefore, the rejection is considered to be clearly erroneous and must be withdrawn.

Furthermore, Applicants note that Maiocco et al. has an effective filing date of April 16, 2004. The effective filing date of the pending application is December 12, 2003. The pending application claims priority to United Kingdom Application No. 0311006.1, which was filed on May 13, 2003. The Examiner acknowledged the Applicants claim for priority in the Office Actions dated March 11, 2008 and March 12, 2009.

The pending application's filing date and application date were clearly before the filing of Maiocco et al. However, Maiocco et al. claims priority to Provisional Application Nos. 60/442,021 and 60/442,023. In order for the Examiner to rely on column 9, lines 25-49 of Maiocco et al. to disclose, for example

> wherein the processing occurs in accordance with the information from the database if
> no user preference has been indicated for the known contact addresses, the user
> preference indicates when a request is to be forked in parallel or sequentially

as recited in claim 1, the above-identified provisional applications must provide support for the subject matter relied upon in Maiocco et al. If the provisional applications do not support the subject matter

relied upon in Maiocco et al., then Maiocco et al. cannot be used as a prior art reference. In the instant case, nothing was found in the provisional applications to support the subject matter of column 9, lines 25-29 of Maiocco et al. Therefore, the Examiner has erroneously relied upon Maiocco et al. to reject the above-mentioned limitation of claim 1.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not rely upon column 9, lines 25-29 of Maiocco et al. for at least the reasons presented below.

According to Maiocco et al., when the C program script (CSP) is launch (every five minutes), the CSP makes a query to a database to determine the list of the active customers. (Maiocco et al., column 9, lines 25-29). For each customer, the CSP polls each customer device in parallel and not serially. (*Id.*). Each forked process queries the database again to determine that customer's IP address and object identification information. (*Id.*). In other words, Maiocco et al. describes a program that runs every five minutes to determine the customer's IP address and objection identification information rather than a "processing the requested in accordance with the information from the database...if no user preference has been indicated for the known contact addresses" (claim 1, lines 7-9).

Furthermore, in claim 1, "the user preference indicat[es] if a request is to be forked in parallel or sequentially " (claim 1, lines 9-10). This is clearly not the case in Maiocco et al. Instead, Maiocco et al. simply discusses that the CSP polls each customer device in parallel and each forked process queries the database again to determine that customer's IP address and object identification information. However, in no way would Maiocco et al. disclose to a person of ordinary skill in the art how "the user preference indicates when a request is to be forked in parallel or sequentially" (claim 1, lines 9-10) with respect to "processing the request in accordance with the information from the database...if no user preference has been indicated for the known contact addresses" (claim 1, lines 7-9).

Therefore, in view of the above, Applicants respectfully submit that Maiocco et al. cannot be used to disclose, either expressly or implicitly, at least

> wherein the processing occurs in accordance with the information from the database if no user preference has been indicated for the known contact addresses, the user preference indicates when a request is to be forked in parallel or sequentially

as recited in claim 1.

Furthermore, nothing was found in Sanchez-Herrero et al., Costa-Requena et al., and Ohsawa et al. to cure the above-mentioned deficiencies of claim 1. Therefore, Applicants respectfully submit that the combination of Sanchez-Herrero et al., Costa-Requena et al., Maiocco et al. and Ohsawa et al. is deficient, as none of the references disclose, either expressly or implicitly, at least, the above-quoted features of claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

The independent claims, which each have their own scope, recite features similar to claim 1. Therefore, Applicants respectfully request that the rejection of the independent claims be withdrawn for reasons similar to those discussed above with respect to claim 1. Applicants respectfully submit that the dependent claims inherit the patentable features of their respective base claims, from which they depend upon. Therefore, Applicants respectfully request that the rejection of the dependent claims should be withdrawn for at least the same reasons as their respective base claims, and for the specific limitations recited therein.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: PTO/SB/33 Form
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